

- D1
Cost
- (d) R_3 is hydrogen;
- (e) R_4 , R_5 , R_6 , and R_7 are optionally present and are each independently selected from (i) the group consisting of hydrogen, alkyl, alkoxy, aryl, aryloxy, alkaryl, alkaryloxy, halogen, trihalomethyl, $S(O)R$, SO_2NRR' , SO_3R , SR , NO_2 , NRR' , OH , CN , $C(O)R$, $OC(O)R$, $NHC(O)R$, $(CH_2)_n CO_2R$, and $CONRR'$ or (ii) any two adjacent R_4 , R_5 , R_6 , and R_7 taken together form a fused ring with the aryl portion of the oxindole-based portion of the indolinone;
- (f) n is 0, 1, 2, or 3;
- (g) R is H, alkyl or aryl;
- (h) R' is H, alkyl or aryl; and
- (i) A is a pyrrole ring, optionally substituted at one or more positions with alkyl, alkoxy, aryl, aryloxy, alkaryl, alkaryloxy, halogen, trihalomethyl, $S(O)R$, SO_2NRR' , SO_3R , SR , NO_2 , NRR' , OH , CN , $C(O)R$, $OC(O)R$, $NHC(O)R$, $(CH_2)_n CO_2R$ or $CONRR'$.

REMARKS

Claims 8 - 11 are pending. Claim 8 has been amended to remove non-elected subject matter. Entry of the amendments is respectfully requested.

I. Non-elected Subject Matter

On page 2 of the Office Action, the Examiner alleges that claims 8 - 11 are objected to as containing non-elected subject matter. In light of the amendments to claim 8, the rejection has been overcome. Withdrawal and reconsideration of the rejection is respectfully requested.

II. Rejection under the Judicially Created Doctrine of Obviousness-type Double Patenting

On page 3 of the Office Action, the Examiner has rejected claims 8 - 11 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 15 and 16 of U.S. Patent No. 6,313,158; and claims 1, 5, 22 and 28 of U.S. Patent No. 5,792,783. Further, the Examiner alleges that claims 8 and 9 are unpatentable over claims 1 and 3 of U.S. Patent No. 6,395,734; and claims 1 and 16 of co-pending Application No. 09/769,198, now U.S. Patent No. 6,531,502.

In light of the terminal disclaimer filed herewith, Applicants assert that this rejection has been overcome. Withdrawal and reconsideration of the rejection is respectfully requested.

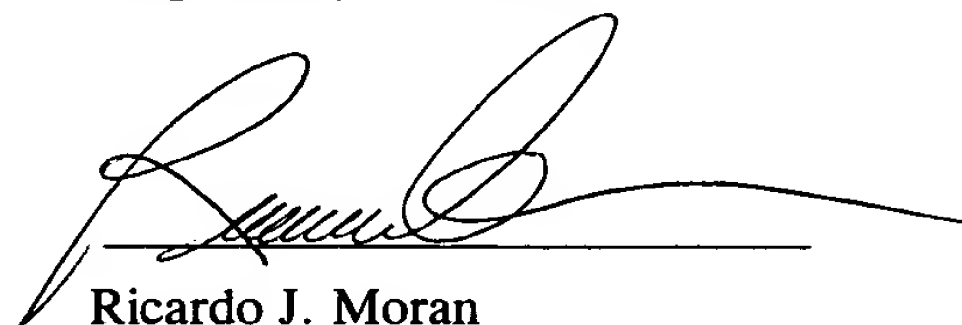
III. Conclusion

In view of the above remarks and amendments, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. Examiner Wright is invited to telephone the undersigned at the number listed below if she believes such would be helpful in advancing the application to issue.

Respectfully submitted,

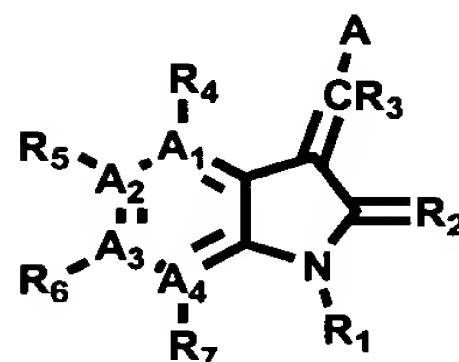
April 18, 2003
Date

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Ricardo J. Moran
Reg. No. 48,735

Marked-up Claim:

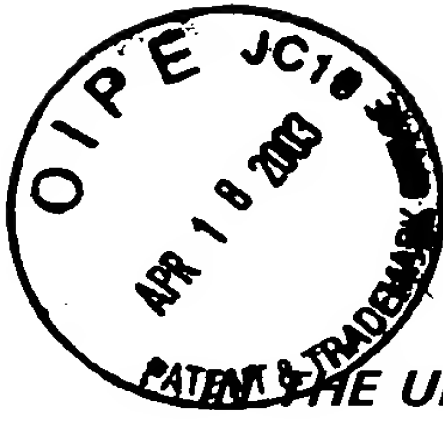
8. (Twice amended) A compound having the formula VI



(VI)

or a pharmaceutically acceptable salt thereof, wherein:

- (a) ~~A₁, A₂, A₃, and A₄ are independently carbon or nitrogen wherein at least one of A₁, A₂, A₃ or A₄ is nitrogen, it being understood that when A₁, A₂, A₃ or A₄ is nitrogen, R₄, R₅, R₆ or R₇ does not exist, respectively;~~
- (b) R₁ is hydrogen or alkyl;
- (c) R₂ is oxygen or sulfur;
- (d) R₃ is hydrogen;
- (e) R₄, R₅, R₆, and R₇ are optionally present and are each independently selected from (i) the group consisting of hydrogen, alkyl, alkoxy, aryl, aryloxy, alkaryl, alkaryloxy, halogen, trihalomethyl, S(O)R, SO₂NRR', SO₃R, SR, NO₂, NRR', OH, CN, C(O)R, OC(O)R, NHC(O)R, (CH₂)_n CO₂R, and CONRR' or (ii) any two adjacent R₄, R₅, R₆, and R₇ taken together form a fused ring with the aryl portion of the oxindole-based portion of the indolinone;
- (f) n is 0, 1, 2, or 3;
- (g) R is H, alkyl or aryl;
- (h) R' is H, alkyl or aryl; and
- (i) A is a pyrrole ~~five membered heteroaryl ring selected from the group consisting of thiophene, pyrrole, pyrazole, imidazole, 1,2,3 triazole, 1,2,4 triazole, oxazole, isoxazole, thiazole, isothiazole, furan, 1,2,3 oxadiazole, 1,2,4 oxadiazole, 1,2,5 oxadiazole, 1,3,4 oxadiazole, 1,2,3,4 oxatriazole, 1,2,3,5 oxatriazole, 1,2,3 thiadiazole, 1,2,4 thiadiazole, 1,2,5 thiadiazole, 1,3,4 thiadiazole, 1,2,3,4 thiatriazole, 1,2,3,5 thiatriazole, and tetrazole, optionally substituted at one or more positions with alkyl, alkoxy, aryl, aryloxy, alkaryl, alkaryloxy, halogen, trihalomethyl, S(O)R, SO₂NRR', SO₃R, SR, NO₂, NRR', OH, CN, C(O)R, OC(O)R, NHC(O)R, (CH₂)_nCO₂R or CONRR'.~~



Atty. Dkt. No. 038602-1220

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APR 22 2003

TECH CENTER 1600/2900

Applicant: Peng-Cho TANG, et al.

Title: INDOLINONE COMBINATORIAL LIBRARIES
AND RELATED PRODUCTS AND METHODS
FOR THE TREATMENT OF DISEASE

Appl. No.: 09/897,755

Filing Date: 07/03/2001

Examiner: Sonya N. Wright

Art Unit: 1626

TERMINAL DISCLAIMER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Your Petitioner, SUGEN, INC., having its principal place of business at 230 East Grand Avenue, South San Francisco, CA 94080 (hereinafter represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/897,755, filed 07/03/2001 by virtue of an Assignment filed and recorded on 12/21/2001, on Reel/Frame 012390/0876, in the United States Patent and Trademark Office, a copy of which is attached hereto.

Further, your Petitioner represents that it is the owner of U.S. Patent No. 6,313,158, which issued on U.S. Patent Application Serial No. 09/100,854, filed 06/19/98, by virtue of an Assignment filed and recorded on 06/19/98, on Reel/Frame 9298/0322, in the United States Patent and Trademark Office, a copy of which is attached hereto.

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Your Petitioner also represents that it is the owner of U.S. Patent No. 5,792,783, which issued on U.S. Patent Application Serial No. 08/655,223, filed 06/05/96, by virtue of an Assignment filed and recorded on 08/07/96, on Reel/Frame 8089/0945, in the United States Patent and Trademark Office, a copy of which is attached hereto.

Further your Petitioner represents that it is the owner of U.S. Patent No. 6,395,734, which issued on U.S. Patent Application Serial No. 09/322,297, filed 05/28/99, by virtue of an Assignment filed and recorded on 07/16/99, on Reel/Frame 010123/0715, in the United States Patent and Trademark Office, a copy of which is attached hereto.

Further your Petitioner represents that it is the owner of U.S. Patent No. 6,531,502, which issued on U.S. Patent Application Serial No. 09/762,198, filed 02/05/01, by virtue of an Assignment filed and recorded on 05/22/01, on Reel/Frame 011825/0030, in the United States Patent and Trademark Office, a copy of which is attached hereto.

Your Petitioner, SUGEN, INC., hereby disclaims the terminal part of the term of any patent granted on the above-identified application which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of U.S. Patent Nos. 6,313,158; 5,792,783; 6,395,734; and 6,531,502, and hereby agrees that any patent so granted on the above-identified application, shall be enforceable only for, and during such period that the legal title to any patent granted on the above-identified application shall be the same as the legal title to U.S. Patent Nos. 6,313,158; 5,792,783; 6,395,734; and 6,531,502, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Your Petitioner, SUGEN, INC., hereby disclaims the terminal part of the term of any patent granted on the above-identified application which would extend beyond the full statutory term, as presently shortened by any terminal disclaimer, of U.S. Patent Nos. 6,313,158; 5,792,783; 6,395,734; and 6,531,502, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent Nos. 6,313,158; 5,792,783; 6,395,734; and 6,531,502, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

The undersigned, being the Attorney of Record for U.S. Patent Application 09/897,755, and duly authorized to act on behalf of Petitioner, certifies that she has reviewed the Assignments attached hereto, and to the best of her knowledge and belief, legal title to U.S. Patent Application 09/897,755 and any patent granted on U.S. Patent Application 09/897,755 rests with Petitioner, SUGEN, INC.. The undersigned declares that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date 4/18/03

FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

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By Beth A. Burrous

Beth A. Burrous

Attorney for Applicant

Registration No. 35,087